

### **REMARKS**

Claims 1-2, 4-9, 11-13, 15-20, and 22-26 are pending in the present application. Claims 1, 8, 19, 23, and 25 were amended. Reconsideration of the claims is respectfully requested. Amendments to claims 1 and 23 were made in response to antecedent basis and statutory rejections and not in response to any art rejection. These amended claims have not changed in scope with respect to whether the claims are patentable over the cited references.

#### **I. Examiner Interview**

Applicant thanks Examiner Nguyen for all the courtesies extended Applicant's representative during the October 10, 2005 telephone interview. During the interview, Examiner agreed that the above amendment to claim 23 would overcome the rejection of claims 23-26 under 35 U.S.C. 101. Examiner also agreed that the above amendment to claim 1 would overcome the rejection of claims 1-2, and 4-7 under 35 U.S.C. 112. Applicant's representative discussed the prior art of record and the manner in which *Guedalia* fails to teach or disclose the features recited in the presently claimed invention in independent claims 1, 12, and 23. The Examiner agreed to consider Applicant's arguments. The arguments discussed as well as additional reasons that the claims are patentable over the prior art of reference are set forth in the remarks below.

#### **II. 35 U.S.C. § 101: Claims 23-26**

The examiner has rejected claims 23-26 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

The examiner states on pages 2-3 of the Office Action dated July 12, 2005 that:

Claims 23-26 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 20 line 28- page 21 line 8, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., a floppy disk, a RAM, CD-ROMs) and intangible embodiments (e.g., signal bearing media, transmission-type media, light wave transmissions). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the

specification at the bottom, carrier medium and transmission media would be not statutory but storage media would be statutory.

Office Action dated July 12, 2005, pages 2-3.

Independent claim 23 has been amended to more clearly set forth the structural limitations needed to bring it within 35 U.S.C. § 101. Amended independent claim 23 now recites a "computer program product, in a tangible computer readable medium." Thus, independent amended claim 23 now recites as follows:

23. A computer program product, in a tangible computer readable medium, for magnifying a portion of a document in a browser, comprising:
- instructions for presenting a first document in a first display in the browser on a client;
  - instructions for generating a magnified display of the first document in a memory at the client;
  - instructions for displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document;
  - instructions for mapping the selected portion of the magnified display to a display space of the selected portion of the first document; and
  - instructions for, in response to receiving a request for an action within the second display performing the action with respect to the first document.

Thus, independent claim 23 is directed to statutory subject matter and the rejection of claim 23 under 35 U.S.C. 101 has been overcome.

Also, since claims 24-26 depend from claim 23, the same distinctions for the claimed invention in claim 23 holds true for claims 24-26 and the rejection of these claims under 35 U.S.C. § 101 has also been overcome. Therefore, the rejection of claims 23-26 under 35 U.S.C. § 101 has been overcome.

### **III. 35 U.S.C. § 112, Second Paragraph: Claims 1-2 and 4-7**

The examiner has rejected claims 1-2 and 4-7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

The examiner states on page 3 of the Office Action dated July 12, 2005 that:

a. The phrase "a client" (claim 1, line 3) is indefinite. Since "the browser" claim basis in the preamble, it is unclear to the Examiner which client is being referred to.

b. Dependent claims 2 and 4-7 are rejected for fully incorporating the deficiencies of their base claim.

Office Action dated July 12, 2005, page 3.

The Examiner believes that the phrase "a client" in line 3 of claim 1 is indefinite. Claim 1 previously recited "presenting a first document in a first display in the browser on a client." Claim 1 has now been amended to claim "presenting a first document in a first display in the browser on **the client**." Amended claim 1 now claims as follows:

1. A method for magnifying a portion of a document in a browser on a client, comprising:
  - presenting a first document in a first display in the browser on **the client**;
  - generating a magnified display of the first document in memory at the client;
  - displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document;
  - mapping the selected portion of the magnified display to a display space of the selected portion of the first document; and
  - responsive to receiving a request for an action within the second display, performing the action with respect to the first document.

Therefore, the rejection under 35 U.S.C. 112 has been overcome regarding independent claim 1. Dependent claims 2, and 4-7 are rejected for fully incorporating the deficiencies of their base claim. Thus, the rejection of dependent claims 2 and 4-7 has also been overcome.

Therefore, the rejection of claims 1-2 and 4-7 under 35 U.S.C. § 112, second paragraph has been overcome.

**IV. 35 U.S.C. § 103, Obviousness; Claims 1-2, 4-7, 12-13, 15-18 and 23-24**

The examiner has rejected claims 1-2, 4-7, 12-13, 15-18 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over Guedalia, U.S. Patent No. 6,121,970 (hereinafter "*Guedalia*") in view of Sussman, U.S. Patent No. 5,586,196 (hereinafter "*Sussman*"). This rejection is respectfully traversed.

In rejecting the claims, the examiner states:

As to independent claim 1:

a. Guedalia teaches method for magnifying a portion of a document in a browser on a client (see Abstract), comprising:

(i) presenting a first document in a first display in the browser on a client (e.g., receiving by the client computer from the server an HTML page, Abstract/col. 4, lines 29-41/col. 5, lines 52-53/col. 8, lines 51-52);

(ii) generating a magnified display of the first document in memory at the client (e.g., a user 32, who operates the client computer 20, interactively controls the image portion displayed ... views the display screen; col. 12, lines 51-58);

(iii) displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document (e.g., a second HTML page, generated by the server, in response to the sub-region which was selected; col. 18, lines 45-51);

(iv) response to receiving a request for an action within the second display, and performing the action with respect to the first document (e.g., items 86-94 in Fig.4).

b. Guedalia teach image map (image maps; col. 14, line 33); however, does not explicitly teach "mapping the selected portion of the magnified display to a display space of the selected portion of the first document."

c. Sussaman teaches mapping the selected portion of the magnified display to a display space of the selected portion of the first document (col.29, lines 42-45/ col.30, lines 37-46&Fig.21).

d. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Angiulo in the system of Sussaman because it would provided the capability for achieving the desired display effects while minimizing memory and computing requirements through a combined hardware/software strategy based on a specific organization of computer memory.

Office Action dated July 12, 2005, pages 4-5.

**A. The Examiner bears the burden of establishing a *prima facie* case of obviousness.**

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, the examiner has failed to establish a *prima facie* case of obviousness because the cited references do not teach the features of the present invention as believed by the examiner and the references cannot be properly modified or combined to reach the presently claimed invention for the reasons stated below.

**B. All claim limitations must be considered, especially when missing from prior art.**

In comparing *Guedalia* to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination.

**1. Independent Claims 1, 12, and 23**

Independent claim 1, which is representative of other rejected independent claims 12 and 23 with respect to similarly recited subject matter, claims as follows:

1. A method for magnifying a portion of a document in a browser on a client, comprising:
  - presenting a first document in a first display in the browser on the client;
  - generating a magnified display of the first document in memory at the client;
  - displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document;
  - mapping the selected portion of the magnified display to a display space of the selected portion of the first document; and
  - responsive to receiving a request for an action within the second display, performing the action with respect to the first document.

For example, *Guedalia* fails to teach all of the features in the generating, displaying, mapping, or performing steps in claim 1. The specific features lacking in this cited reference are discussed below.

**i. Generating a magnified display of the first document in memory at the client.**

*Guedalia* fails to teach or suggest "generating a magnified display of the first document in memory at the client," as is recited in independent claim 1. The Examiner believes this feature is taught by *Guedalia* at column 12, lines 51-58, which teaches as follows:

A user 32, who operates the client computer 20, interactively controls the image portion displayed within the HTML page by means of an input device such as a mouse and keyboard 34. The HTML page with the image portion embedded therein is displayed on a display device 36. The user 32 views the display screen and in turn adjusts the image portion being viewed by issuing commands via the mouse and keyboard 34.

*Guedalia*, column 12, lines 51-58.

In this cited section, *Guedalia* teaches that a user may interactively control display of an embedded image at the client through the use of a keyboard and mouse. The user may adjust

display qualities of an image displayed to the user by issuing commands through the mouse and keyboard to control image display. However, user inputs received through the mouse and keyboard do not generate a magnified display of the first document in memory at the client.

*Guedalia* teaches:

However, for both flat 2D and panoramic images, in order to render the portion of the image to be displayed, the client computer has to have received a corresponding portion of the archived image data from the server computer. This in turn requires that new data be transmitted in response to each interactive user command, which leads to a non-smooth interactive user experience, whereby the navigation appears to proceed in "spurts."

*Guedalia*, column 12, lines 6-14.

Thus, as shown above, *Guedalia* teaches that a user requests download and display of an embedded image from a server by using a mouse and keyboard. The client may only display an enlarged image portion if the server transmits the enlarged image portion to the client. If the server is unable to transmit the enlarged image, the client will be unable to display an enlarged image. Thus, *Guedalia* merely teaches display at the client of an embedded image sent by the server to the client. Although the embedded image may be an enlarged portion of a first image in order to simulate a zoom-in function while user interactively views the image at the client, the client is merely displaying an image received from the server that is an enlarged portion of a previous image received from the server, rather than generating an enlarged image. In fact, *Guedalia* specifically teaches that the enlarged image portion is generated at the server rather than at the client. *Guedalia* teaches:

receiving by said client computer a second HTML page, generated by said server computer, in response to said sub-region which was selected, wherein said second HTML page contains a link to a second image, the second image being an enlarged portion of the first image, and the enlarged portion of the first image corresponding to the selected location; and

*Guedalia*, column 18, lines 45-51(subsection of claim 12).

Here, *Guedalia* teaches a server generates an enlarged portion of a first image and sends it to a client for display in response to a client request. Thus, the reference does not teach, suggest, or provide any incentive for generating a magnified display of any kind at the client in this or any

other section of the reference. In contradistinction, the presently claimed invention in claim 1 recites "generating a magnified display of the first document in memory at the client."

Furthermore, *Guedalia* teaches that the enlarged image sent by the server to the client is only a portion of the first image. A magnified display of the entire first document in memory at the client is not taught or suggested in this or any other section of the reference. Thus, *Guedalia* merely teaches display of successive images sent to a client from a server in response to a client request to view embedded images. The enlarged image is not generated in memory at the client nor is it a magnified display of the entire first document in memory at the client. The cited portion of *Guedalia* regarding a user adjusting the display of an image via a mouse and keyboard is insufficient to teach or suggest "generating a magnified display of the first document in memory at the client." Therefore, the cited references fail to teach or suggest "generating a magnified display of the first document in memory at the client," as is recited in independent claim 1.

ii. Displaying in a second display a selected portion of the magnified display.

*Guedalia* fails to teach or suggest "displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document," as is recited in claim 1. The Examiner alleges this feature is taught by *Guedalia* at column 18, lines 45-51, which is quoted above. As discussed above, *Guedalia* merely teaches a server generating an enlarged image portion and sending the image to a client for display. If the client does not receive the image from the server, the client cannot display an enlarged image on the browser. In contradistinction, the magnified image of the presently claimed invention is generated in memory on the client.

Moreover, *Guedalia* does not teach, suggest, or mention displaying the enlarged portion of the first image in a second display in the browser. *Guedalia* teaches:

The browser encounters the IIP command sequence and sends an IIP request for image data 58 to the server. The server parses the request, accesses the necessary FLASH-PDX® image tiles, assembles them into a rectangular image portion 60, and sends the new image back to the client. In turn, the client then displays the HTML page with the new image portion embedded within in it.

*Guedalia*, column 15, lines 4-10.

Here, *Guedalia* teaches that the server generates the image portion for display and sends it to the client. The client displays the HTML page with the new image embedded within it. *Guedalia*

does not teach or suggest display of the "selected portion of the magnified display" in a second display in the browser. Thus, the cited reference fails to teach or suggest "displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document," as is claimed in claim 1.

iii. Responsive to receiving a request for an action in the second display,  
performing the action with respect to the first document.

*Guedalia* fails to teach or suggest "responsive to receiving a request for an action within the second display, performing the action with respect to the first document," as is recited in claim 1. The Examiner believes this feature is taught by *Guedalia* in Figure 4, items 86-94, which is shown as follows:

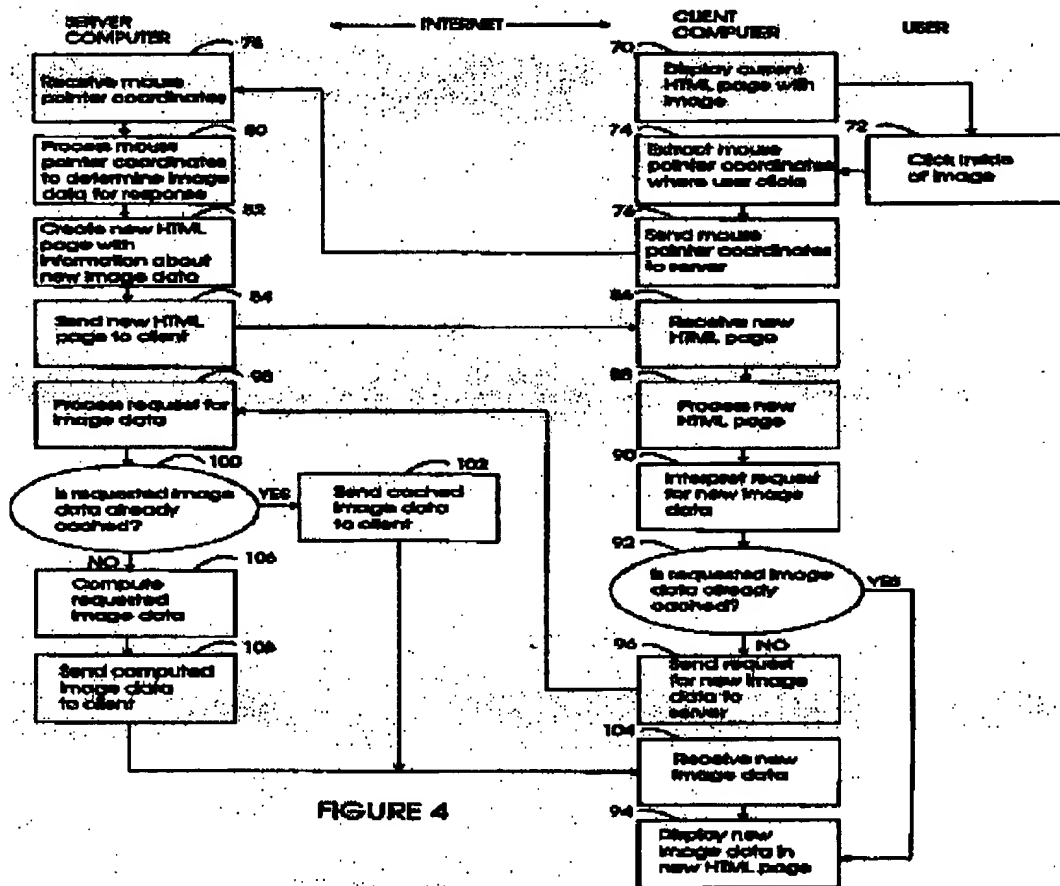


FIGURE 4

*Guedalia*, Figure 4.



As can be seen in the figure, *Guedalia* teaches that a user requests display of an embedded image by clicking inside an image, the coordinates for the mouse pointer are sent to the server, the server creates a new HTML page with new image data, the new HTML page is sent to the client, and if the embedded image requested by client is already in cache the image is displayed, otherwise, the image must be requested from the server. The text of *Guedalia* for the cited figure teaches:

At step 86 the client receives the new HTML page, and at step 88 the browser processes the page. At step 90 the browser recognizes that the HTML page contains a link to an embedded image portion. At step 92 the client checks whether that embedded image portion is already resident in its local cache. If so, then the page can be displayed at once at step 94, with the embedded image rendered. Otherwise, at step 96 the client sends the request for the image portion back to the server.

*Guedalia*, column 15, lines 42-50. As shown above, *Guedalia* merely teaches a server sending image data to a client for display. The cited figure merely emphasizes the fact that if the client wishes to display an enlarged image portion of a previously displayed image, the enlarged image portion must be sent by the server to the client in response to user selecting a link to an embedded image portion to request display of the embedded image. Merely selecting a link for an embedded image portion in an HTML page to request download and display of the embedded image is insufficient to teach or suggest receiving a request for an action within a second display displaying a magnified portion of the first document.

Although the embedded image sent to the client by the server may be an enlarged image portion, *Guedalia* does not teach or suggest "a request for an action" within that enlarged image portion. In fact, the only action taught by *Guedalia* is clicking on a location that contains an embedded image portion to request download and display of the embedded image. Once the embedded image is displayed, no further action with respect to a displayed embedded image portion is suggested by the reference.

Moreover, *Guedalia* merely teaches a server sending the requested embedded image to the client for display. *Guedalia* does not teach, suggest, or even mention performing an action with respect to the first document in response to receiving a request for an action in the selected portion of the magnified display in the second display. Once an embedded image in the first HTML page is selected and the embedded image is downloaded and displayed, *Guedalia*

does not provide for any further action of any kind with respect to the first HTML page. In fact, as shown above, *Guedalia* does not even suggest that the first HTML page continues to be displayed after the new embedded image is requested, received, and displayed at the client, thereby negating any suggestion that a further action could be taken with regard to the first HTML page. Thus, *Guedalia* fails to teach or suggest "responsive to receiving a request for an action within the second display, performing the action with respect to the first display document," as is claimed in independent claim 1.

iv. Mapping the selected portion of the magnified display.

The prior art of reference fails to teach or suggest "mapping the selected portion of the magnified display to a display space of the selected portion of the first document," as is recited in claim 1. The Examiner acknowledges that *Guedalia* fails to teach this feature. However, the Examiner believes that *Sussman* teaches mapping the selected portion of the magnified display to the display space of the selected portion of the first document. *Sussman* teaches:

The DDM display management software sub-system provides a unique solution to the problem of scaling coordinates between a source image bitmap buffer and a toroidal display buffer using non-integer scaling ratios, without accumulation of coordinate errors, and while dynamically re-mapping page geometry to obtain continuous line and continuous column effects.

Key concepts in the implementation of the display management are: gridding (exact coordinate conversion using truncation); clipping (obtaining precise registration, or "stitching", of template zoom operations while obtaining single pixel edge positioning); zone mapping (maintaining a representation of the document as presented to the user in terms of the offsets of zones in the source page image bitmap to the screen origin); rolling (toroidal buffer management); cursor pair (display cursor and page cursor representing same point in screen space and in page space); and explicit and implicit cursor types.

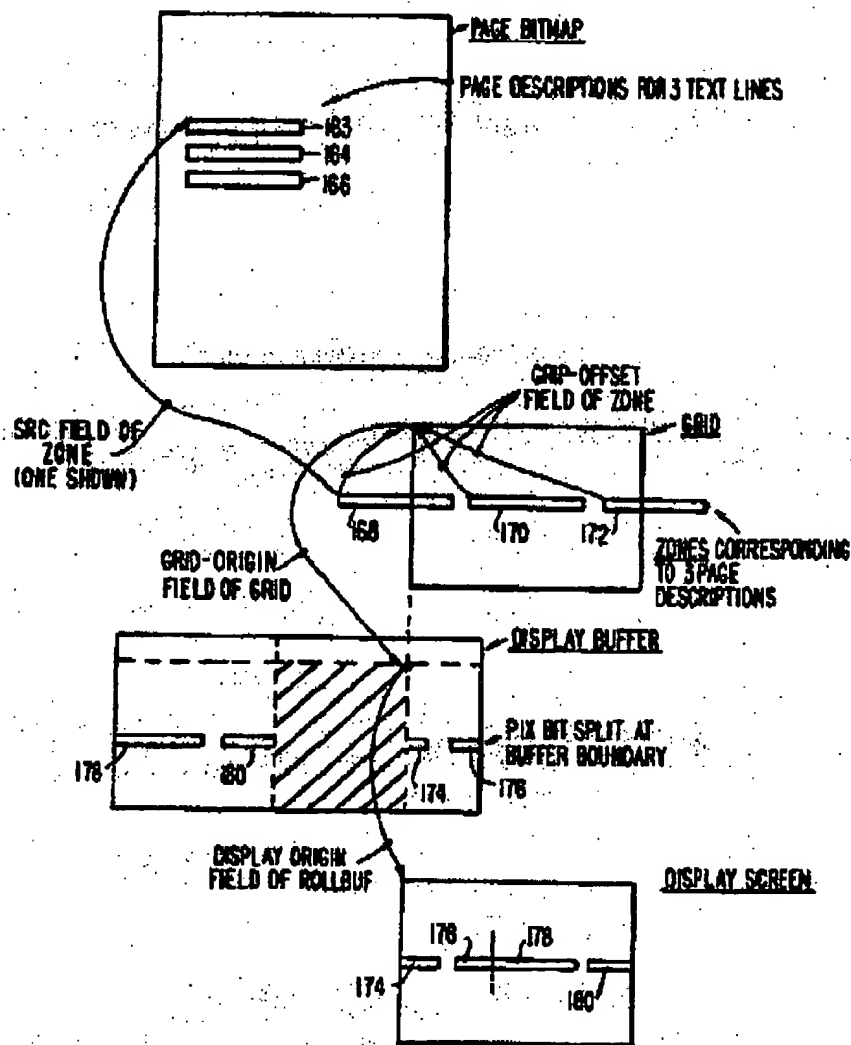
*Sussman*, column 29, lines 30-45.

Additionally, since the page image is reconstructed to the display screen with a different geometry than found on the original page, a coordinate translation also applies between the two cursor "spaces." This translation varies with the presentation mode employed: continuous text-lines, continuous text-columns, etc.

The DISP\_CUR and PAGE\_CUR together contain all of the positional information needed to relate a reading location in a set of document images (PAGES) to a location on the display screen. The two cursors are together termed the "cursor pair", and are of central importance in the external control of the display sub-system. The cursor pair maps a point on the display screen to the page image. Since all operations on the display sub-system are specified in terms of the cursor pair, the display sub-system may be described as "cursor driven".

The design of the display sub-system provides accurate and consistent scaling and translation of cursor coordinates between the two cursor "spaces."

*Sussman*, column 30, lines 31-49.



**FIG. 21**

*Sussman*, Figure 21.

Here, *Sussman* teaches a digital document magnifier for scanning and digitizing printed information by scanning a printed document to create a document image and then utilizing zone

mapping of the display to the document image. A representation of the offsets of zones in the source document image is maintained because the document is displayed with a different geometry and format on the display screen than was present in the original scanned document image. Thus, *Sussman* teaches a scanned document may be displayed with continuous text-lines or continuous text-column effects that were not present in the original scanned document image.

However, the teachings of *Sussman* are insufficient to disclose "mapping the selected portion of the magnified display" in a second display in the browser "to a display space of the selected portion of the first document" in the first display in the browser. As discussed above, *Sussman* merely teaches mapping between a document image in an image buffer and a document display. *Sussman* fails to teach or suggest mapping between a selected portion of a first document in a first display and a selected portion of a magnified display in a second display. Thus, *Sussman* fails to teach or suggest "mapping the selected portion of the magnified display to a display space of the selected portion of the first document," as is claimed in independent claim 1.

Therefore, independent claim 1 is not obvious in view of *Guedalia* and *Sussman*, either alone or in combination, because the features believed to be disclosed by the cited references are not present. Moreover, independent claims 12 and 23 recite subject matter addressed above with regard to claim 1 and are distinguishable over the prior art of reference under the same rationale presented above with regard to independent claim 1.

## **2. Independent Claims 8, 19, and 25**

The examiner has rejected claims 8-9, 11, 19-20, 22 and 25-26 under 35 U.S.C. § 103(a) as being unpatentable over *Guedalia* in view of *Hsing et al.* (U.S. Patent No. 6,826,726) (hereinafter "*Hsing*"). This rejection is respectfully traversed.

The examiner states on pages 8-9 of the Office Action dated July 12, 2005 that:

As to independent claim 8:

a. *Guedalia* teaches a method for magnifying a portion of a document in a browser (e.g., the HTML page ... the second image being an enlarged portion of the first image; see Abstract), comprising:

- (i) presenting a first document in a first display in the browser (e.g., receiving by the client computer from the server an HTML page; Abstract/col.4, lines 29-41/col.5, lines 52-53/col.8, lines 51-52);
- (ii) receiving a selection of a portion of the first document (e.g., sending by the client computer to the server computer an indication of the subregion selected by the user; Abstract);

(iii) presenting the magnified display (e.g., the second image being an enlarged portion of the first image, and the enlarged portion of the first image corresponding to the selected location; Abstract / col. 13, lines 60-67 and col. 17, lines 56-61);

(iv) receiving a request for an action within the magnified display; and performing the action with respect to the magnified display (e.g., items 86-94 in Fig.4).

b. Guedalia does not explicitly teach "analyzing a document object model for the first document; and identifying a portion of the document object model that corresponds to the selected portion of the first document."

d. Hsing teaches analyzing a document object model for the first document (col.3, line 60-col.4, line 9); and identifying a portion of the document object model that corresponds to the selected portion of the first document (col.4, lines 30-44 and Fig. 8).

e. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Hsing in the system of Guedalia because it would have provided the capability for reducing the number of accesses from client to server that will require the transmission of only the smallest amount of data is necessary to provide complete information for the server to update its database.

Office Action dated July 12, 2005, pages 8-9.

Independent claims 8, 19, and 25 also recite subject matter addressed above with regard to independent claims 1, 12, and 23. Thus, the same distinctions between the cited prior art references and claim 1 discussed above are applicable to independent claims 8, 19, and 25 with regard to the similarly recited subject matter. In addition, *Guedalia* fails to teach or suggest "analyzing a document object model for the first document" and "identifying a portion of the document object model that corresponds to the selected portion of the first document," as is recited in claims 8, 19, and 25. Independent amended claim 8, which is representative of other rejected independent claims 19 and 25 with respect to similarly recited subject matter, claims as follows:

8. A method for magnifying a portion of a document in a browser, comprising:

- presenting a first document in a first display in the browser;
- receiving a selection of a portion of the first document;
- generating a magnified display of the selected portion from the structure of the first document;
- analyzing a document object model for the first document;

identifying a portion of the document object model that corresponds to the selected portion of the first document, wherein the magnified display of the selected portion of the first document is generated at a client based on the corresponding portion of the document object model for the first document;

presenting the magnified display;

receiving a request for an action within the magnified display; and

performing the action with respect to the magnified display.

The Examiner acknowledges that *Geudalia* does not teach "analyzing a document object model for the first document; and identifying a portion of the document object model that corresponds to the selected portion of the first document," as recited in claim 8. However, the Examiner believes Hsing teaches this feature at col. 3, line 60-col.4, line 9 and col. 4, lines 30-44 and Fig. 8. Hsing teaches as follows:

As is shown in the flow chart of FIG. 1, changes made to a local database 100 are registered as "events" by Event Listener 110. In the XML-DOM specification, as applied in the invention, an event occurs whenever a node is added or deleted, or the data in a field is modified. In FIG. 1, events 120 are detected at Event Listener 110 and passed to Change Manager 130 where they are listed as records in Event Table 300. When modifications to the XML database have been completed, the Change Manager 130 parses Event Table 300 to determine which nodes in the DOM tree are affected by the events listed in the Event Table. The parsing creates a second list of changes (the "Save Table") to be transmitted to the computer on which the main database resides which, when applied to the main database, will update that database with the remotely-performed changes, thus keeping the client and server data in synchronization. This second list represents the smallest number of modifications that must be made to fully update the database resident on the server. The Save Table may be compressed with any commercial compression product for transmission to the server where the database will be modified in accordance with data received from the Synch Manager.

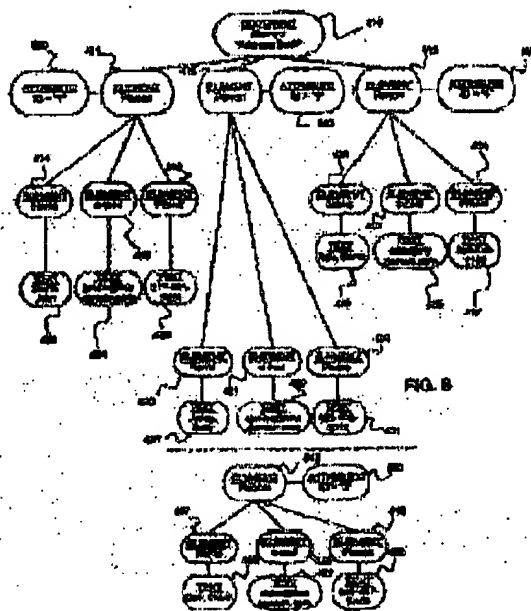
*Hsing*, column 3, line 60-column 4, line 14.

Here, *Hsing* merely teaches that when changes are made to a local database, a main database on a server may be updated to reflect the changes made at the local database by parsing an Event Table to determine which nodes in a DOM tree are affected by the changes. A list of changes is then transmitted to the main database on the server for updating the main database to keep the local and main databases in synchronization with one another. *Hsing* teaches that an event occurs when a node is added or deleted.

*Hsing* also teaches:

FIG. 2b shows the address book represented as an XML document. In the XML specification, a "document" may constitute almost any object having properties that include a value. The XML structure reflects the organization of the database. Thus, the XML tag <address book> 250, represents the database, and is located at the highest level. Each database record 260, defined as a "person," is located at an intermediate level, and has a unique ID attribute that uniquely identifies it and distinguishes it from other elements at the same level. Discrete data elements representing the data in each field of each record are located at the lowest level. In FIG. 2b, the XML tag <person ID="1"> 260 is at the intermediate level, while data maintained under the XML tags for <name> 270, <phone> 280, and <email> 290 are located at the lowest level.

*Hsing* column 4, lines 30-44.



*Hsing*, Figure 8.

As discussed above, *Hsing* merely teaches that a main database is updated to reflect changes made to a document at a local database. The DOM has a plurality of nodes such that each node corresponds to an XML tag and data element in the XML document. Thus, *Hsing* merely teaches updating a DOM to conform to changes to an XML document when a node is

added or deleted. However, the cited portion of *Hsing* does not teach or suggest magnifying a portion of a document in a browser comprising "analyzing a document object model for a first document" and "identifying a portion of the document object model that corresponds to the selected portion of the first document" as is claimed in independent claim 1.

Moreover, *Hsing* fails to teach or suggest "wherein the magnified display of the selected portion of the first document is generated at a client based on the corresponding portion of the document object model for the first document," as is now recited in amended independent claim 8. As discussed above, *Hsing* merely teaches utilization of document object model to update a main database at a server to reflect changes made to a local database. A magnified display of the selected portion of the first document generated based on the corresponding portion of the document object model for the first document is not taught or suggested in any section of the reference. Thus, *Hsing* fails to teach or suggest "analyzing a document object model for the first document" and "identifying a portion of the document object model that corresponds to the selected portion of the first document, wherein the magnified display of the selected portion of the first document is generated at a client based on the corresponding portion of the document object model for the first document," as is claimed in amended independent claim 8.

In addition, independent claims 19 and 25 recite subject matter addressed above with regard to claim 8 and are distinguishable over the prior art of reference for the same reasons set forth above with regard to claim 8. Therefore, independent claims 8, 19, and 25 are not obvious in view of *Guedalia* and *Hsing*, either alone or in combination, because the features believed to be disclosed by this cited reference are not present.

### 3. Dependent Claims

At least by virtue of their dependency on independent claims 1, 8, 12, 19, 23, and 25 dependent claims 2, 4-7, 9, 11, 13, 15-20, 22, 24, and 26 are distinguishable over the prior art of reference. Furthermore, dependent claims 2, 4-7, 9, 11, 13, 15-20, 22, 24, and 26 recite other additional combinations of features not taught or suggested by the prior art of reference.

For example, as to dependent claims 11 and 22, the Office Action alleges that *Guedalia* teaches adjusting attributes of nodes based on a magnification factor at column 16, lines 58-column 17, line 10, which recites as follows:

Specifically, as described above, the browser sends both client state information and mouse coordinates to the server. The tokens received are the view window delimiters x1o, y1o, x2o, y2o, the pixel dimensions w, h,



and the relative mouse coordinates  $x, y$ . The arrays `click_array_x1[ ]`, `click_array_y1[ ]`, `click_array_y2[ ]` specify five sub-regions. For example, the first sub-region is the middle rectangle extending from (0.25, 0.25) to (0.75, 0.75), and the second sub-region is the L-shaped area in the lower left, described by the part of the rectangle extending from (0.0, 0.0) to (0.5, 0.5) which excludes the previous rectangle. The arrays `goto_array_x1[ ]`, `goto_array_y1[ ]`, `goto_array_x2[ ]` and `goto_array_y2[ ]` specify the image portion to be used for the response. In the example shown, the first response portion is the image portion in the middle rectangle extending from (.25, 0.25) to (0.75, 0.75) and the second response portion is the image portion in the lower left rectangle extending from (0.0, 0.0) to (0.5, 0.5).

The out.print calls at the end of the listing do the actual writing of the dynamic HTML page.

Hsing column 16, line 58-col. 17, line 10.

As shown above, Guedalia is merely describing the process whereby the browser sends client state information and mouse coordinates to the server indicating which image sub-region has been selected by the user. The cited portion of Guedalia merely identified the coordinates of the selected sub-region responsive to user request. Nowhere in the cited reference does Guedalia teach adjusting the attributes of nodes in the portion of the document object model on a magnification factor.

**C. A proper *prima facie* case of obviousness must be supported by some teaching or suggestion in the prior art.**

A proper *prima facie* case of obviousness must be supported by some teaching or suggestion contained in the combined references. Applicant respectfully submits that the cited references cannot be combined to produce the claimed invention. *Guedalia* and *Sussman*, either alone or in combination, do not give any teaching, suggestion, or incentive to generate a magnified display of a first document in memory at the client; display a selected portion of the magnified display in a second display in the browser; map the selected portion of the magnified display to a display space of the selected portion of the first document; and perform an action with respect to the first document in response to receiving a request for an action within the second display. The Examiner alleges it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the feature from *Angulo* in the system of *Sussman* because it would have provided the capability for achieving the desired display effects

while minimizing memory and computing requirement through a combined hardware/software strategy based on specific organization of computer memory.

Applicant notes that *Angiulo* is not one of the cited references in the Examiners rejection of claims. This is the first reference to *Angiulo* made in reference to independent claim 1. Thus, Applicant assumes Examiner intended to say the feature from *Guedalia* was included in the system of *Sussman*. However, even if one were motivated to combine *Guedalia* and *Sussman*, the references fail to teach or suggest the features for generating a magnified display of a first document in memory at a client and mapping the selected portion of the magnified display to the selected portion of the first document such that receiving a request for a first action in the second display would permit performing the action with respect to the first document. As discussed above, *Guedalia* and *Sussman*, either alone or in combination, fail to teach or suggest the features recited in the presently claimed invention in independent claims 1, 8, 12, 19, 23, and 25. Thus, any alleged combination of the prior art of reference cannot render obvious the claimed features generating a magnified display of a first document in memory at a client and mapping the selected portion of the magnified display to the selected portion of the first document such that receiving a request for a first action in the second display would permit performing the action with respect to the first document because the cited references fail to teach or suggest these features.

Furthermore, nowhere does *Guedalia* or *Hsing* teach, suggest, or given any incentive to analyze a document object model for a first document and identify a portion of the document object model that corresponds to the selected portion of the first document, wherein a magnified display of the selected portion of the first document is generated at the client based on the corresponding portion of the document object model for the first document. The Examiner believes it would have been obvious to combine the features from *Hsing* and *Guedalia* because it would have provided the capability for reducing the number of accesses from client to server that will require the transmission of only the smallest amount of data necessary to provide complete information for the server to update its database. However, Applicant notes that independent claims 8, 19, and 25 do not claim transmission of data from a server to a client. To the contrary, and as discussed above, claims 8, 19, and 25 now recite a magnified display "generated at the client" based on the document object model for the first document. Thus, the Examiner's

proposed incentive is not applicable and the Examiner has failed to point out a teaching, suggestion, or incentive in the prior art to analyze a document object model for a first document and identify a portion of the document object model that corresponds to the selected portion of the first document, wherein a magnified display of the selected portion of the first document is generated at the client based on the corresponding portion of the document object model for the first document as is claimed in independent claims 8, 19, and 25. Therefore, the Examiner has failed to set forth a proper *prima facie* case of obviousness.

**D. Stating that it is obvious to try or make a modification or combination without a suggestion in the prior art is not *prima facie* obviousness.**

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir 1989); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Examiner may not merely state that the modification or combination would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification. As discussed above, the prior art fails to offer any suggestion or incentive for the proposed combination and modification of the references.

**E. *Guedalia* teaches away from the presently claimed invention.**

Furthermore, *Guedalia* actually teaches away from the presently claimed invention since *Guedalia* directs one to download an embedded image from a server that may be an enlarged image portion of another image for display rather than magnifying an entire document at the client and displaying the selected portion of the magnified document in a second display. *See In re Hedges*, 228 U.S.P.Q. 685 (Fed. Cir. 1986). Therefore, *Guedalia* actually teaches away from the presently claimed invention as recited in independent claims 1, 8, 12, 19, 23, and 25 because *Guedalia* teaches generating a magnified image at the server and sending the image to the client for display. Thus, one of ordinary skill in the art would not be motivated to make the changes proposed by the Examiner.

**F. The proposed modification of *Guedalia* would not be made when *Guedalia* is considered as a whole.**

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Hedges, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). The present invention recognizes the problem encounter by users that are visually impaired and/or have difficulty with fine motor movements locating and selecting links on a web page. The prior art of reference does not teach the problem or its source. Instead, *Guedalia* is directed towards problems associated with image navigation on a client with latency of server processing and network communication. *Guedalia* states:

The drawback with this client-less approach to image navigation is that it is very processing-heavy on the server side. For every interactive user command, the server has to render a customized image to embed in the dynamic HTML page. Given the rapid pace with which interactive user commands are issued, this puts a heavy burden on the server, greatly slowing down its performance. Moreover the combined latency of the server processing and the network communication makes the user experience "bumpy" rather than a "smooth" interactive experience; i.e. the navigation experience appears more like a slide show than a continuous animation.

*Guedalia*, column 3, lines 45-57.

*Guedalia* overcomes this problem by caching images for display. According to *Guedalia*, an enlarged image is not generated at a client but is generated at a server and downloaded to the client. Thus, when *Guedalia* is examined as a whole, *Guedalia* teaches one of ordinary skill in the art to magnify an image portion at a server. Moreover, *Sussman* is concerned with the problem of magnifying printed material. *Sussman* states:

This invention relates to a system for magnifying printed materials. More particularly, this invention relates to a system in which printed material for documents is digitized and processed by a microprocessor, and then displayed for viewing.

*Sussman*, column 1, lines 14-18.

*Sussman* solves the problem by scanning a printed document, magnifying the document contents and altering the configuration of the content for display to user. *Hsing* is directed towards updating a main database to reflect changes made to a local database using the smallest number of events to update the database. *Hsing* teaches:

This invention relates to a system for updating and synchronizing a document on a network server from a remote device. More specifically, this invention uses the Document Object Model (DOM) specification to manipulate documents, including databases that conform to the XML document structure specification, to enable remote workstations, or clients, to update through the transmission of the minimum amount of information necessary to fully update the server's database, it is suitable for applications, including wireless transmission, transmissions in which the connection between the client and server is of limited bandwidth, transmissions using conventional telephone lines, and transmissions through computer networks using physical media.

*Hsing*, column 1, lines 8-23.

Thus, each of the references provides a complete solution to the problem addressed. Thus, one of ordinary skill would not be motivated make the examiner's proposed modifications to reach the presently claimed invention when *Guedalia* is considered as a whole.

Moreover, the inventions disclosed in the prior art of reference are entirely different from each other. *Guedalia* is directed towards the image navigation on a network where server processing and network latency is a problem. *Guedalia* teaches:

The present invention provides a novel approach to client-less HTML-driven interactive image navigation over the Internet. It operates through the medium of image maps, and is designed in such a way as to allow for efficient caching on both the client and server sides, so as to reduce network latency for the client and also boost server performance.

*Guedalia*, column 3, lines 60-65.

Thus, *Guedalia* teaches image navigation over a network. In contradistinction, *Sussman* is directed to scanning and enlarging printed material. *Sussman* teaches:

These and other objects of the invention are accomplished in accordance with the principles of the invention by providing a system which scans and digitizes printed information, processes the information, and outputs the processed information to a display screen. The digital document magnifier of the present invention uses a format analyzer to determine the contents of a document, and then automates presentation of the document to the viewer.

*Sussman*, column 1, lines 48-56.

As shown above, *Guedalia* and *Sussman* teach two entirely different inventions. Therefore, one of ordinary skill in the art would not be motivated to combine or modify *Guedalia* and *Sussman* in the manner required to reach the presently claimed invention.

**G. The presently claimed invention may be reached only through an improper use of the disclosed invention as a template to piece together and modify the prior art.**

The presently claimed invention may only be reached through an improper use of the disclosed invention as a template to piece together and modify the prior art. The Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, the cited references cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of applicant's disclosure a model for the needed changes. Thus, the presently claimed invention in claims 1-2, 4-9, 11-13, 15-20, and 22-26 are allowable over the prior art of reference.

Therefore, the rejection of claims 1-2, 4-9, 11-13, 15-20, 22-26 under 35 U.S.C. § 103(a) has been overcome.

**V. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



Mari Stewart

Reg. No. 50,359

Duke W. Yee

Reg. No. 34,285

Yee & Associates, P.C.

P.O. Box 802333

Dallas, TX 75380

(972) 385-8777

Attorneys for Applicants